

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/502,285      | 02/11/00    | GOLDBERG             | 3367-2-2            |

Joseph E. Kovarik Esq.  
SHERIDAN ROSS P.C.  
1560 Broadway  
Suite 1200  
Denver CO 80202-5141

QM22/1108

EXAMINER

WHITE, C

ART UNIT

3713

PAPER NUMBER

DATE MAILED: 11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/502,285      | 02/11/00    | GOLDBERG             | 3367-2-2            |

Joseph E. Kovarik Esq.  
SHERIDAN ROSS P.C.  
1560 Broadway  
Suite 1200  
Denver CO 80202-5141

QM22/1109

EXAMINER

WHITE, C

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/502,285

Applicant(s)

GOLDBERG ET AL.

Examiner

Carmen D. White

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 97-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 97-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***IDS***

The examiner requests that Applicant submit a copy of the references on page 6, paper #3 of the information disclosure statement. Presently, these references have not been considered by the examiner.

### ***Abstract***

The abstract of the disclosure is objected to because it is longer than 150 words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length (as set forth in the rule change of rule 1.72 in the PBG-PGP rule package of 10/10/00) since the space provided for the abstract on the computer tape used by the printer is limited.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-7 have been renumbered 97-103, and will be referred to as 97-103 throughout the rest of this communication.

### ***Trademark/Trade Name in Claims***

Claim 97-99 and 103 contain the trademark/trade name Internet. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a specific type of network that is constantly being changed and updated and, accordingly, the identification/description is indefinite.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 97, 98, 99, 100, 101, 102 and 103 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 14, 19, 21, 120, 131 and 132, respectively, of U.S. Patent No. 6,183,366 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because in some cases the wording is slightly different; however, all the limitations of the claims of the instant invention are disclosed in the claims of USPN 6,183,366 B1.

Claims 97 and 98 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 16, respectively, of U.S. Patent No. 6,264,560 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because in some cases the wording is slightly different; however, all the limitations of the claims of the instant invention are disclosed in the claims of USPN 6,264,560 B1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 97-100 and 102-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al or Reilly et al.

Regarding claims 97-100 and 102, Marsh or Reilly teach the features of advertising via the Internet by allowing the user to access the Internet via an Internet

service provider; presenting a first advertisement while the user is viewing a Web page or various data via the Web; transmitting data (the user's input from clicking on the advertisement) in response to the presentation of the advertisement; and second, and subsequent, presenting of various other types of advertisement presentations (Reilly- col. 4, lines 8-15; col. 5, lines 1-3; col. 5, lines 35-37; col. 5, lines 61-67; col. 6, lines 1-6; col. 16, lines 62-67 through col. 17, lines 1-17; col. 6, lines 33-52; Fig. 6; Marsh- col. 4, lines 21-29; col. 7, lines 1-6 and lines 13-20; Fig. 3 and Fig. 4). The references are silent on explicitly teaching the second presentation being determined using the data input by the user. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marsh or Reilly in order to present new advertisements of specific interest to a particular user. It is well known in the art of Internet advertisement to obtain demographic data of Internet users and send advertisements that are deemed to be of interest to that particular user.

Regarding claim 103, Marsh or Reilly teaches all the limitations of the claims as discussed above. The references are silent about the feature of the activation of the play of a game through the network service. However, it is well known to play games via the Internet. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include a game web site as the particular type of web site accessed in Marsh or Reilly as an obvious matter of choice well within the functional capability of the systems of Marsh or Reilly.

Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh or Reilly in view of Gifford.

Regarding claim 101, Marsh or Reilly discloses all the limitations as discussed above. The references are silent as to the purchase of an advertised product or service over the network. In an analogous network advertising system, Gifford teaches the purchase of advertised merchandise via a computer network (abstract; Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the purchase feature in Marsh or Reilly in order to allow the user the convenience of purchasing the merchandise/service at the time of the advertisement. This would increase sales of the advertised product/service. Further it is well known in the art of Internet commerce to have pop advertisements on various web pages that allow the user to make immediate purchases. (AOL is well known for having pop up advertisements that showcase a particular product or service that the user can immediately purchase.)

***Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Judson, Small, Graber et al ('769), Graber et al ('860), Baron et al, Levergood et al, and Cragun et al teach computer network advertising systems.

***USPTO Contact Information***

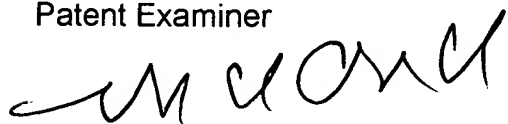
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



C. White  
Patent Examiner



**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**